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JUN 06 2005

OFFICE OF PETITIONS

In re Application of	:	
Timothy Breeden and Doug Dew	:	
Application No. 10/733,989	:	DECISION REFUSING
Filed: December 11, 2003	:	STATUS UNDER
Title of Invention:	:	37 CFR 1.47
SYSTEM AND METHOD FOR SOFTWARE	:	
APPLICATION DEVELOPMENT IN A PORTAL	:	
ENVIRONMENT	:	

This is in response to the Request for Reconsideration of Petition, filed April 27, 2005, to allow the other inventor(s) to proceed with the application on behalf of himself or herself and the nonsigning inventor(s). The four (4) month extension of time request is hereby granted.

The petition is **dismissed**.

Rule 47 applicant is given TWO (2) MONTHS from the mailing date of this decision to reply, correcting the below-noted deficiencies. Any reply should be entitled "Request for Reconsideration of Petition Under 37 CFR 1.47(a)", and should only address the deficiencies noted below, except that the reply may include an oath or declaration executed by the non-signing inventor. Failure to respond will result in abandonment of the application. Any extensions of time will be governed by 37 CFR 1.136(a).

The above-identified application was filed on December 11, 2003, without a fully executed oath or declaration. The Office mailed a Notice to File Missing Parts of Nonprovisional Application (hereinafter "Notice"), on April 27, 2004, requiring *inter alia*, an executed oath or declaration.

In response to the Notice, Applicant filed a petition on September 30, 2004 under 37 CFR 1.47(a), to allow the other inventor(s) to proceed with the application on behalf of himself or herself and the nonsigning inventors.

In support of the petition the Applicant filed a Declaration Under 37 CFR §1.47 on Behalf of Signing Inventors in Support of Petition to Accept Declaration in Response to a Missing Parts Without the Signature of a Joint Inventor, executed by Karl F. Kenna, wherein Mr. Kenna declared that formal papers, "namely a Declaration for Patent Application and an Assignment" were sent to the nonsigning inventor via email and via Federal Express, and have not been returned. Kenna Declaration at p.2.

The petition was dismissed in a decision mailed October 25, 2004, for failing to meet the requirements of a grantable petition under 37 CFR 1.47(a). Applicant was advised that "[b]efore an inventor can refuse to sign an oath or declaration, he must have been presented with a copy of the application papers (specification, claims and drawings). See MPEP 409.03(d)." October 25, 2004 Decision Dismissing Petition at pp.2-3. Applicant was further advised that "Applicant must present a copy of the application papers to the inventor." Id.

Finally, the petition noted that the "[a] review of the oath or declaration filed with the instant petition reveal[ed] that the citizenship of inventor Dew [wa]s missing from the declaration. An oath or declaration that includes the inventor's citizenship is required." October 25, 2004 Decision Dismissing Petition at p.3.

The instant Request for Reconsideration

Applicant files the instant Request for Reconsideration and provides that Applicant learned of inventor Dew's new home address "in Champaign, Illinois, and subsequently Applicant's attorney sent a follow-up letter via FedEx. Copies of the letter and tracking receipt showing delivery on August...27, [2]004 are attached..." Reconsideration Request at p.3.

A review of the letter reveals that the letter references the Declaration and Assignment in the first paragraph, and states that "[for your convenience, we are enclosing another set of documents..." The letter then requests, in the second paragraph, that Applicant review the Declaration and Assignment and execute the documents. The third paragraph requests a return of the original documents in a self-addressed envelope provided by

Applicant. There is no mention in the letter that a copy of the above-identified application was included with the letter.

Applicant further provides that several emails were sent to inventor Dew; however, Applicant learned after the last of the emails had been sent, that "the host name could not be found." Reconsideration Request at p.3.

Applicant concludes with the assertion that a diligent effort has been made in an attempt to contact inventor Dew. Reconsideration Request at p.4.

Applicant has also filed several copies of the oath/declaration; however, none of the Declarations have been corrected to include the citizenship.

Applicable Law

A grantable petition under 37 CFR 1.47(a) requires: (1) proof that the non-signing inventor cannot be reached or refuses to sign the oath or declaration after having been presented with the application papers (specification, claims and drawings); (2) an acceptable oath or declaration in compliance with 35 U.S.C. §§ 115 and 116; (3) the petition fee; and (4) a statement of the last known address of the non-signing inventor. Applicant lacks items (1) and (2).

As to item (1), Applicant is advised that there are two situations provided for: a) where an inventor refuses to sign the application papers, and b) where an inventor cannot be found or reached after diligent effort. Both situations are separate and distinct and require separate and distinct proofs before a petition may be granted.

Here, Applicant alleges that a diligent effort has been made in an attempt to contact inventor Dew.

Applicant is advised that diligent effort is only required where Applicant is asserting that an inventor is unavailable (cannot be reached). In that instance, while it is not required that the application (specification, claims and drawings), be mailed to the inventor, Applicant must establish the exercise of diligent effort in trying to find or reach the nonsigning

inventor. The MPEP provides that a statement of facts should be submitted that fully describes the exact facts which are relied on to establish that a diligent effort was made to locate the inventor. (Emphasis supplied). See, MPEP § 409.03(d). At the very least, an Internet search, or a search of telephone directories should be undertaken of the regions where it is suspected the non-signing inventor may reside. Copies of the results of such searches must be referred to in any renewed petition.

Conversly, where as here, it is alleged that an applicant refuses to join an application (the inventor's whereabouts are known), the applicant must establish that the nonsigning inventor was presented with the application for signature.

Accordingly, as to item (1), where it is alleged that an applicant refuses to join an application, the applicant must establish that the nonsigning inventor was presented with the application for signature. The Manual of Patent Examining Procedure ("MPEP") states that

A refusal by an inventor to sign an oath or declaration when the inventor has not been presented with the application papers does not itself suggest that the inventor is refusing to join the application unless it is clear that the inventor understands exactly what he or she is being asked to sign and refuses to accept the application papers. A copy of the application papers should be sent to the last known address of the nonsigning inventor, or, if the nonsigning inventor is represented by counsel, to the address of the nonsigning inventor's attorney.

MPEP 409.03(d).

As to item (1), applicant failed to show or provide proof that the inventor refused to sign the declaration. Before an inventor can refuse to sign an oath or declaration, he must have been *presented with a copy of the application papers (specification, claims and drawings).* See MPEP 409.03(d).

Applicant must present a copy of the application papers to the inventor.

As to item (2), Applicant has failed to provide an acceptable oath or declaration in compliance with 35 U.S.C. §§ 115 and 116. A review of the oath or declaration filed with the instant petition reveals that the citizenship of inventor Dew is missing from the declaration. An oath or declaration that includes the inventor's citizenship is required.


Further correspondence with respect to this matter should be addressed as follows:

By mail: Commissioner for Patents
 PO Box 1450
 Alexandria, VA 22313-1450

By FAX: (703) 872-9306
 Attn: Office of Petitions

By hand: Customer Service Window
 Randolph Building
 401 Dulany Street
 Alexandria, VA 22314

Telephone inquiries concerning this matter should be directed to the undersigned at (571) 272-3232.



Derek L. Woods

Petitions Attorney
Office of Petitions